



Election / #17
5/21/02

Atty. Dkt. No. 053466/0295

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Yasuo KAISHIHARA

Title: INHIBITOR OF LYMPHOCYTE ACTIVATION

Appl. No.: 09/760,723

Filing Date: January 17, 2001

Examiner: G. Ewoldt

Art Unit: 1644

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RESPONSE TO RESTRICTION REQUIREMENT UNDER 37 C.F.R. 1.143 MAY 20 2002

Commissioner for Patents
Box NON-FEE AMENDMENT
Washington, D.C. 20231

TECH CENTER 1600/2900

Sir:

In response to the restriction requirement set forth in the Office Action mailed March 18, 2002, Applicants hereby elect Group A (an inhibitor of activation of a specific lymphocyte subset, i.e., T cells or B cells), with traverse. This election of claims is made without prejudice to Applicants' right to pursue the non-elected claims in one or more divisional applications in due course.

The Examiner classified the claims into two groups. According to the Examiner, Group A is drawn to an inhibitor of activation of a specific lymphocyte subset, i.e., T cells or B cells. The Examiner asserts that Group B is drawn to a preventive or therapeutic agent of either an autoimmune disease, rejection of organ transplantation, or allergy. It is noted that the Examiner has not made clear which currently pending claims are assigned to which group, thus the restriction requirement is improper. Applicants respectfully traverse this restriction.

To sustain a proper requirement for restriction, the Examiner must demonstrate that the independent and distinct inventions meet two criteria. First, the inventions must be independent or distinct as claimed, and second, there must be a serious burden on the Examiner. Applicants assert that the Examiner has not fulfilled these requirements, as the Examiner has demonstrated that neither the inventions are distinct or independent, nor does a serious burden exist. In making the restriction, the Examiner merely asserts that the "the species are independent and patentable over one another... ." (PTO Prosecution File Wrapper Paper No. 9, page 2). However, "[s]eparate status of the art may be shown by citing patents which are evidence of such separate status [of the inventions], and also of a separate field

of search." (Manual of Patent Examining Procedure, 7th Ed., § 808.02). In the current restriction requirement, the Examiner has not demonstrated by "appropriate explanation" that each subject has attained a separate status in the art by citing patents in support of this contention. (MPEP, 7th Ed., § 803). Thus, the Examiner has merely asserted that the claims in Groups A and B constitute separate inventions, without demonstrating that there would be a serious burden on the Examiner if restriction is not required. Furthermore, the Examiner has not provided any evidence that the inventions are independent and distinct as being patentable over each other or that no relationship exists between the disclosed subjects (MPEP, 7th Ed., § 802.01). Rather, the Examiner has merely asserted, without support, that "different diseases associated with the lymphocyte activation comprise different pathologies and etiologies."

For the reasons indicated above, the restriction requirement is improper and should be withdrawn. Applicants earnestly await receipt of the Office Action on the merits.

If additional extensions of time are necessary to prevent abandonment of this application, then extensions of time are hereby petitioned under 37 C.F.R. §1.136(a), and any fees required, including fees for net addition of claims, are hereby authorized to be charged to account number 19-0741.

Should the examiner believe that further discussion of any remaining issues would advance the prosecution, he or she is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date May 14, 2002

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